

PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

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15 MRS. 2004

Awapatent A/S

WRITTEN OPINION
(PCT Rule 66)

Date of mailing
(day/month/year)

12.03.2004

Applicant's or agent's file reference
99000105/CHE

REPLY DUE

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International application No.
PCT/IB 02/02516

International filing date (day/month/year)
01.07.2002

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01.07.2002

International Patent Classification (IPC) or both national classification and IPC
H04Q7/22

Applicant
NOKIA CORPORATION et al

1. This written opinion is the **first** drawn up by this International Preliminary Examining Authority.
2. This opinion contains indications relating to the following items:
 - I ☒ Basis of the opinion
 - II ☐ Priority
 - III ☒ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
 - IV ☐ Lack of unity of invention
 - V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
 - VI ☐ Certain documents cited
 - VII ☐ Certain defects in the international application
 - VIII ☐ Certain observations on the international application
3. The applicant is hereby **invited to reply** to this opinion.

When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(d).

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also: For an additional opportunity to submit amendments, see Rule 66.4.
For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis.
For an informal communication with the examiner, see Rule 66.6.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.
4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: 01.11.2004

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I. Basis of the opinion

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed"*):

Description, Pages

1-30 as originally filed

Claims, Numbers

1-26 as originally filed

Drawings, Sheets

1/4-4/4 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
 - ☐ the language of publication of the international application (under Rule 48.3(b)).
 - ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).
3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:
- ☐ contained in the international application in written form.
 - ☐ filed together with the international application in computer readable form.
 - ☐ furnished subsequently to this Authority in written form.
 - ☐ furnished subsequently to this Authority in computer readable form.
 - ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
 - ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.
4. The amendments have resulted in the cancellation of:
- ☐ the description, pages:
 - ☐ the claims, Nos.:
 - ☐ the drawings, sheets:
5. ☐ This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).
6. Additional observations, if necessary:

III. Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

1. The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been and will not be examined in respect of:

☐ the entire international application,

☒ claims Nos. 2, 26

because:

☐ the said international application, or the said claims Nos. relate to the following subject matter which does not require an international preliminary examination (specify):

☒ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. 2, 26 are so unclear that no meaningful opinion could be formed (*specify*):

see separate sheet

☐ the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.

☐ no international search report has been established for the said claims Nos.

2. A written opinion cannot be drawn due to the failure of the nucleotide and/or amino acid sequence listing to comply with the Standard provided for in Annex C of the Administrative Instructions:

☐ the written form has not been furnished or does not comply with the Standard.

☐ the computer readable form has not been furnished or does not comply with the Standard.

V. Reasoned statement under Rule 56.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	1, 17, 21
Inventive step (IS)	Claims	3-16, 18-20, 22-25
Industrial applicability (IA)	Claims	

2. Citations and explanations

see separate sheet

Re Item III

Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

1. The subject-matter of **Claim 2** is directed to information characterised solely by its content. Thus, it corresponds to subject-matter excluded from International Preliminary Examination according to Rule 67(v) PCT.
2. Moreover, the subject-matter of **Claim 26** is unclear with respect to the matter for which protection is sought (**Article 6 PCT and PCT Guidelines III-4.1**), following from the multiple undefined dependencies it refers to (**Rule 6.4 PCT**), which does not permit to recognise the ensemble of features defining the claimed apparatus.

Re Item V

Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Reference is made to the following documents:

D1: WO 99/ 457 02 A1
D2: EP 1 109 415 A2
D3: WO 96/ 344 91 A1
D4: US-A-2002 00 264 96
2. It is clear from the description on page 4, lines 12 to 22 that the following features are essential to the definition of the invention:
 - The communication terminal is adapted to respond to a promotion message by communicating an acceptance signal;
 - The communication terminal is adapted to receive a reminder signal communicated by the promotion server.

Since independent **Claim 21** does not contain these features it does not meet the requirement following from **Article 6 PCT** taken in combination with **Rule 6.3(b) PCT** that any independent claim must contain all the technical features essential to the

definition of the invention.

3. The formulation of the present **Claim 25** requires a revision, in order to avoid any doubts as to the category of these claims (PCT Guidelines III-4.1). In this respect, some features are formulated in terms which rather correspond to features of a method (e.g. expressions such as "so that...provides", "when...is busy", etc.) while the claim is generally directed to an apparatus; a reformulation in terms of features clearly falling in the apparatus category is hence necessary (e.g. "means for" or "means arranged to").
4. The relative terms "promotion message", "event", "event manager" and "promotion server" used in **Claims 1, 17 and 21** have no well recognized technical meaning, thereby rendering the definition of the subject-matter of said claims unclear (**Article 6 PCT**). The following reasoning regarding inventive step (see point 4) was made assuming that the mentioned terms ("promotion message", "event", "event manager" and "promotion server") are not significant for the matter for which protection is sought.
5. The term "operable" used in **Claim 1** is vague and unclear and leaves the reader in doubt as to the meaning of the technical features to which it refers, thereby rendering the definition of the subject-matter of said claim/s unclear (**Article 6 PCT**). The same objection also applies to **Claims 13 to 15 and 24**.
6. The above clarity objection to **Claim 1** notwithstanding, the present application does not meet the requirements of **Article 33(2) PCT**, because the subject-matter of **Claim 1** is not novel.

Document **D1**, which is considered to represent the most relevant state of the art, discloses, according to the features of **Claim 1** (applying the terminology of present **Claim 1** and the references to **D1**), a system for communicating a promotion message to one or more communication terminals, which promotion message is associated with an event having defined a start time (page 8, line 17 to page 9, line 12), said system comprising:

- an event manager (television distribution facility 38, fig. 1) for providing said event to one or more receivers starting from said defined start time (the time the

program is scheduled, see page 11, lines 7-14) and for generating a promotion message request;

- a promotion server ("Main facility" 32 containing "Guide database" 34 and "Advertising Database" 36) for communicating said promotion message to said one or more communication terminals through at least one communication network in response to receiving said promotion message request from said event manager through a connection interconnecting said event manager and said promotion server (page 7, line 27 to page 8, line 16);
- said one or more communication terminals being operable to respond to said promotion message by communicating an acceptance signal through said at least one communication network to said promotion server (page 11, lines 22-32);
- said promotion server comprising a register (a user profile, like disclosed at page 25, lines 17-32) for associating an accepting communication terminal of said one or more communication terminals with said promotion message on reception of said acceptance signal from said accepting communication terminal (accepting an advertised pay-per-view program, like described at page 19, lines 6-18);
- said promotion server being operable to communicate a reminder signal for said event (fig. 5 and 6) to said accepting communication terminal through said first communication network (page 16, line 17 to page 17, line 7).

All the features of **Claim 1** are thus known from **D1**, the subject-matter of **Claim 1** is therefore not novel and does not satisfy the criterion set forth in **Article 33(2) PCT**.

It is furthermore noted that even if the Applicant would interpret the disclosure of document **D1** in a slightly different manner than the examiner has done in the above analysis, and based on his interpretations would come to the conclusion that there are differences between the subject matter of present **Claim 1** and **D1** which would then establish novelty, then these differences, even if they could be acknowledged as such, would only be of so minor nature that they could not be the basis for establishing the presence of any inventive step, as **D1** discloses the same object and

the same type of solution as the present application , and **Claim 1** would, even with such a difference in interpretation, not meet the requirements of **Article 33(3) PCT**.

7. The same considerations as made in respect of **Claim 1** are also valid for independent **Claims 17 and 21**, which contains a corresponding feature combination as **Claim 1** in terms of a claim relating to a method and an apparatus respectively. Therefore, the subject-matter of **Claims 17 and 21** is not novel and does not satisfy the criterion set forth in **Article 33(2) PCT**.
8. The additional features of dependent **Claims 3 to 16, 18 to 20 and 22 to 25** do not add anything of inventive significance to **Claims 1, 17 and 21** to which they respectively refer because they relate to minor details and are either directly derivable from the above-mentioned prior art document **D1, D2, D3 and D4**, or represents standard practice.

Therefore, the subject-matter of **Claims 3 to 16, 18 to 20 and 22 to 25** does not involve an inventive step (**Article 33(3) PCT**).

9. It is not at present apparent which part of the application could serve as a basis for an inventive subject-matter.

Should the Applicant nevertheless regard some particular matter as novel and inventive, an independent claim including such matter should be filed. The Applicant should also indicate in the letter of reply the difference of the subject-matter of newly filed claims vis-à-vis the state of the art and the significance thereof.

10. Any new independent claim should be in the two-part form recommended by **Rule 6.3(b) PCT**.

If the Applicant is of the opinion that a two-part form of the claim would be inappropriate he is invited to provide reasons in his reply. In addition, the Applicant should ensure that it is clear from the description which features of the subject-matter of the independent Claims are known from the state of the art.

11. All claims should include reference signs relating to the technical features referred to therein, **Rule 6.2(b) PCT**.

12. The opening part of the description should be modified to bring it into agreement with any amended independent claims, **Rule 5.1(a)(iii) PCT**.
13. In order to meet the requirements of **Rule 5.1(a)(ii) PCT**, the cited documents **D1**, **D2**, **D3** and **D4** should be acknowledged and briefly discussed in the opening part of the description.
14. In order to facilitate the examination of the conformity of the amended application with the requirements of **Article 34(2)(b) PCT**, the Applicant is requested to clearly identify the amendments carried out, no matter whether they concern amendments by addition, replacement or deletion, and to indicate the passages of the application as filed on which these amendments are based (**see also Rule 66.8(a) PCT**).

If the Applicant regards it as appropriate these indications could be submitted in handwritten form on a copy of the relevant parts of the application as filed.